



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,426	12/12/2003	Marion Heinz	12251	2304

28484 7590 12/10/2007  
BASF AKTIENGESELLSCHAFT  
CARL-BOSCH STRASSE 38, 67056 LUDWIGSHAFEN  
LUDWIGSHAFEN, 69056  
GERMANY

EXAMINER
----------

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
----------	--------------

1796

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

12/10/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lori.hass@basf.com  
marjorie.ellis@basf.com  
fernando.borrego@basf.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/735,426	<b>Applicant(s)</b> HEINZ ET AL.	
	<b>Examiner</b> Rabon Sergeant	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 and 16-18 is/are allowed.
- 6) ☒ Claim(s) 8-15 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

1. Claims 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claims 11-14, Component bv) is not mutually exclusive from Components biii) or biv); specifically Component bv) overlaps Components biii) and biv), in terms of functionality and molecular weight. As drafted, a single specific reactant will satisfy the requirements of multiple components; accordingly, one of ordinary skill could not clearly determine the metes and bounds of the claim, since one could not determine if multiple components, though overlapping, are required. Applicants' argument that polyols are distinguished from monomeric alcohols is not well taken. As evidenced by the definitions within Sax et al., polyols or polyhydric alcohols are so named due to their multiple functional groups and not due to the presence of polymeric linkages, and it is specifically noted that polyols or polyhydric alcohols are a subgrouping of alcohols (i.e.; alcohols encompass polyols); accordingly, applicants' argument that polyols are distinguished from monomeric alcohols because they must be polymeric is incorrect. In fact, no definitive distinction can be made between multifunctional alcohols and polyols, since each designation may encompass monomeric or polymeric species. The position is maintained that to define the components as claimed introduces a degree of ambiguity into the claims that renders the claims indefinite, and it is not seen that applicants' amendment has in any way clarified the situation.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 8-15 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Bartz et al. (US 2001/0051261).

Bartz et al. disclose compact polyurethanes produced from polyisocyanates which may be higher than difunctional (note the use of p-MDI and mixtures thereof within paragraph [0025]) and polyol components that meet those claimed. Applicants' components bi), bii), and biii) are met by the reference's component b13). In view of the reference's use of the plural terminology, "polyether alcohols", the position is taken that the reference's component b13) encompasses mixtures of such polyols. This position is further bolstered by the fact that the reference's components b11) and b12) are referred to in the singular. Applicants' component biv) are met by the reference's component b11). Applicants' component bv) is met by the reference's component b12). See paragraphs [0001] through [0029], [0031], and [0034].

4. Applicants' arguments have been considered; however, they are insufficient to overcome the prior art rejection. Despite applicants' arguments, as aforementioned, the position is taken that the reference's component b13) encompasses mixtures and the position is taken that one of ordinary skill in the art would have readily envisioned the use of mixtures from the disclosure. Secondly, applicants have argued that the reference fails to disclose applicants' polyol components with sufficient specificity to anticipate the claims. In response, given that the reference is considered to encompass a mixture of polyols b13), that applicants' various polyols continue to meet the disclosed polyols, and that quantities of polyols are claimed that overlap those disclosed, the position is taken that the teachings of the reference are adequate to

anticipate the claims. Furthermore, the fact that component b13) may be optional does not negate the fact that it is disclosed.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

  
RABON SERGENT  
PRIMARY EXAMINER

R. Sergent  
December 5, 2007